

O-363-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2640280  
BY DENIM MERCHANTS (UK) LIMITED TO REGISTER  
THE TRADE MARK:

**CRAFTED WITH CONVICTION**

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 104528 BY  
REPUBLIC (IP) LTD

## BACKGROUND

1. On 29 October 2012, Denim Merchants (UK) Limited (“the applicant”) applied to register the mark shown on the cover page of this decision. The application was published for opposition purposes on 23 November 2012, for the following goods in class 25:

Clothing, footwear and headgear.

2. The application was opposed by Republic (Retail) Ltd (in administration). Following an assignment and change of name, the opponent is now Republic (IP) Limited. Although the application was initially opposed on the basis of sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), in a letter to the Trade Marks Registry (“TMR”) dated 17 February 2014, the opponent withdrew the ground based upon section 5(4)(a) of the Act. Insofar as the opposition based upon section 5(2)(b) is concerned, the opposition is directed against all of the goods in the application with the opponent relying upon the following UK and Community Trade Mark (“CTM”) registrations and goods:

UK no. 2489397 for the trade mark: **CRAFTED** applied for on 5 June 2008 and the registration process for which was completed on 18 December 2009:

**Class 25** - Articles of clothing; footwear; headgear; belts.

CTM no. 5983648 for the trade mark:



applied for on 8 June 2007 and the registration process for which was completed on 6 April 2009:

**Class 25** - Articles of clothing; footwear; headgear; belts.

3. In its Notice of opposition, the opponent states:

“The mark applied for is visually very similar to the opponent’s earlier mark, which enjoys a significant reputation as a result of its extensive use over many years. The dominant and distinctive part of both the mark applied for and the opponent’s earlier United Kingdom trade mark registration is the word “Crafted”. There is a genuine and real risk of confusion and/or association between the applicant’s mark and the opponent’s earlier mark on the part of the relevant consumer.”

4. The applicant filed a counterstatement in which the grounds of opposition are denied. The applicant stated:

“2...It is submitted that the word CRAFTED, notwithstanding that it is the first word of the mark applied for, is not the distinctive and dominant component of the mark applied for. The word CRAFTED hangs with and are inseparable from the words WITH CONVICTION such that the distinctiveness of the mark applied for lies in the totality it creates rather than the individual words of which it is made up. Judged through the eyes of the average consumer, who normally perceives a mark as a whole and does not analyse its individual components, the mark CRAFTED WITH CONVICTION is highly unlikely to be mistaken for the mark CRAFTED.

5. Both parties filed evidence. Whilst neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing. I will refer to these submissions, as necessary, below.

## **EVIDENCE**

### **Opponent's evidence**

6. This consists of a witness statement from David Forsey, a Director at the opponent company. Mr Forsey explains that in February 2013, Sports Direct International Plc (“SDI”) acquired certain aspects of the business, assets and brands from the administrators of the fashion retailer Republic (UK) Limited and Republic (Retail) Limited. SDI acquired 114 Republic branded stores as well as Republic’s own brands including CRAFTED. SDI is, he states, the UK’s leading sports retailer with approximately 400 stores across the UK. Following the acquisition, Mr Forsey explains that SDI merged the Republic business into its USC brand.

7. The CRAFTED brand is, he states, used by the opponent and its related companies in connection with articles of clothing, footwear, headgear, bags and accessories. Retail sales of CRAFTED branded goods have, explains Mr Forsey, been made through a number of channels, including USC stores and on-line through the USC website at [www.usc.co.uk](http://www.usc.co.uk). Exhibit DMF1 consists of screen shots dated 14 February 2014 taken from [www.usc.co.uk](http://www.usc.co.uk) and [www.sportsdirect.com](http://www.sportsdirect.com). The pages contain details relating to the joining of the Republic and USC brands. The CRAFTED brand is specifically mentioned and the pages provided show use of CRAFTED in relation to various jeans and jeggings, shorts, hotpants, a pair of shoes, caps and a stud bag.

8. When CRAFTED branded goods are sold in USC retail outlets, the mark CRAFTED is, explains Mr Forsey, used on labels, swing tags and on the products themselves. Exhibit DMF 2 consists of “examples of the CRAFTED mark currently in use in connection with clothing, bags, footwear and accessories.” Although the photographs appear to be undated, Mr Forsey’s reference to “currently in use” suggests that they are contemporaneous with his statement i.e. February 2014. The pages provided show the

use of the word CRAFTED on a swing label on bags and jeans, on a label on the waistband of a pair of jeans, on tags to which are attached items of jewellery and printed on the insole of what appears to be a pair of ladies' shoes.

9. Exhibits DM3 and DM4 are described by Mr Forsey as:

“screenshots and printouts from the applicant’s website at [www.judgeandjury.biz](http://www.judgeandjury.biz)

And:

“...an extract from the privacy policy of the Judge and Jury website which makes reference to the applicant, Denim Merchants (UK) Limited.”

Mr Forsey states:

“The mark CRAFTED WITH CONVICTION is used as a sub-brand in connection with the applicant’s JUDGE & JURY brand...This shows the CRAFTED WITH CONVICTION mark being used in connection with clothing.”

10. The screenshots and extracts are all dated 11 February 2014. What relevance they and Mr Forsey’s comments have to the matter before me is unclear.

### **The applicant’s evidence**

11. This consists of a witness statement from Anwaar Adhami, the applicant’s chief financial officer. The statement explains the history of the applicant company and the motivation behind its naming of a range of men’s clothing with an “anti law and order theme”. Exhibit AA consist of an undated photograph of a label which appears on the inside of the waistband of a pair of jeans upon which, inter alia, the words Crafted With Conviction appears. Mr Adhami states:

“4. The decision to adopt the trade mark CRAFTED WITH CONVICTION in 2012 was taken on the bases that firstly the trade mark fits in with the anti-law and order theme of the existing trade marks...(CONVICTION being the judgment of a jury or judge that a person is guilty of a crime as charged) and secondly to indicate that the range of clothing is made (CRAFTED) with skill and careful attention to detail in the certain belief (CONVICTION) of the high quality of the range...”

12. That concludes my summary of the evidence filed to the extent that I consider it necessary.

### **DECISION**

13. The opposition is now based solely upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

In these proceedings, the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As neither of these trade marks had been registered for more than five years when the application was published, they are not subject to proof of use, as per section 6A of the Act.

### **Section 5(2)(b) – case law**

15. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales

## The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

### Comparison of goods

16. The competing goods are:

Opponent’s goods (in both earlier trade marks)	Applicant’s goods
Articles of clothing; footwear; headgear; belts.	Clothing, footwear and headgear.

17. The competing goods are clearly identical.

### The average consumer and the nature of the purchasing decision

18. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. As neither parties’ specifications are limited in any way, the average consumer is the public at large. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

19. As the goods at issue are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, I agree that visual considerations are likely to dominate the selection process, but not to the extent that aural considerations can be ignored. The cost of the goods at issue can vary considerably. In *New Look* the GC also considered the level of attention taken purchasing goods in the clothing sector. It stated:


“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert

that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

20. When selecting the goods at issue, factors such as material, size, colour, cost and compatibility with other items of clothing etc. may all come into play. Rather than the relatively low level of attention the opponent suggests will be paid to the selection process, the average consumer will, in my view, pay a reasonable level of attention when making their selection, a level of attention which is, in my view, likely to increase as the cost and importance of the item increases.

**Comparison of marks**

21. The marks to be compared are:

<b>Opponent’s marks</b>	<b>Applicant’s mark</b>
CRAFTED  	CRAFTED WITH CONVICTION

22. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives. Although the opponent relies upon the two earlier marks shown above, in its submissions the opponent states:

“10. The opponent’s word mark registration is the closer of the two earlier marks when compared with the applicant’s mark due to the absence of any additional stylisation...”

23. I agree that notwithstanding the minimal degree of stylisation present in the second mark, as both marks are registered for the same specification of goods, it is the plain block capital version of the mark that offers the opponent the best prospect of success; if its opposition fails in relation to this mark, it will be in no better position in relation to the second mark shown above.



24. In its submissions, the opponent states:

“10...It is evident that there is a high degree of visual and aural similarity between the marks due to the sole element of the opponent’s mark CRAFTED, being one of the three words comprising the applicant’s mark. In addition, the word CRAFTED is the first element of the opposed mark and will be the first element which will be seen and spoken by consumers. This provides dominance over the additional word elements in the opposed mark. Conceptually, the marks are also similar, with the suffix elements WITH CONVICTION sounding like a tagline or having connotations of effort or quality.”

25. The opponent’s mark consists of the well known English language word CRAFTED presented in block capital letters. I note that [www.collinsdictionary.com](http://www.collinsdictionary.com) defines “craft” as, inter alia, a transitive verb meaning to “make or fashion with skill, esp. by hand.” The word “crafted” is simply the past participle of that verb. As no part of the mark is highlighted or emphasised in any way, any distinctiveness it may possess can only lie in the mark as a whole.

26. Turning to the applicant’s mark, this also contains the word CRAFTED but accompanied by the well known English language words WITH and CONVICTION; all of the words are presented in upper case. In its submissions, the opponent states:

“14. The word CRAFTED is the distinctive and dominant component of the applicant’s mark, with the word retaining an independent and distinctive role within the composite mark...”

27. Although the word CRAFTED appears as the first element of the applicant’s mark, I do not agree with the opponent that it is the dominant element of the applicant’s mark or that it retains an independent distinctive role within it. Rather, I agree with the applicant that:

“2...the word CRAFTED hangs with and are inseparable from the words WITH CONVICTION such that the distinctiveness of the mark applied for lies in the totality it creates rather than the individual words of which it is made up.”

I shall approach the visual, aural and conceptual comparison with those findings in mind.

28. The fact that both parties’ marks either consist of or contain the word CRAFTED as the only element/first element of the mark, inevitably results in a degree of similarity between them. However, the inclusion in the applicant’s mark of the additional words WITH CONVICTION make, in my view, a significant contribution to the applicant’s mark. Overall, I consider the competing marks to be visually and aurally similar to a reasonable degree. Considered from a conceptual perspective, the opponent’s mark is likely to convey the meaning I have referred to above, whereas the applicant’s mark will, in my view, send a more complete and definite conceptual message i.e. to make or

fashion with skill, (especially by hand) with effort/intensity. Whilst there is a degree of conceptual similarity resulting from the shared use of the word CRAFTED, when considered overall, the competing marks are, in my view, conceptually distinguishable.

### **Distinctive character of the opponent's earlier trade mark**

29. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. Although the opponent has filed evidence in these proceedings, as it has not, for example, provided any information regarding the quantum of use it has made of its mark or the extent to which the mark has been promoted, I am simply not in a position to determine if its distinctive character has been enhanced through use; I have, as a consequence, only the inherent characteristics of its mark to consider. Bearing in mind the definition of the word CRAFTED I have highlighted above, the opponent's mark is, when considered in relation to the goods upon which the opponent relies in these proceedings, in my view, possessed of a very low degree of inherent distinctive character.

### **Likelihood of confusion**

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

31. Earlier in this decision, I concluded that: (i) the competing goods are identical; (ii) the average consumer is a member of the general public who will select the goods by predominantly visual means and who will pay a reasonable level of attention when doing so, (iii) neither parties' marks have any distinctive and dominant components, the distinctiveness in each lying in the totalities, (iv) the competing marks are visually and aurally similar to a reasonable degree, and insofar as it is relevant, conceptually distinguishable and (v) the opponent's mark is possessed of a very low degree of inherent distinctive character which, on the basis of the evidence provided, I am unable to conclude has been enhanced by the use made of it.

32. However, as is made clear in the decision of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, it is not permissible for me to regard the opponent's earlier mark as having no distinctive character. In its submissions, the opponent states:

“14...Consumers would perceive the word CRAFTED within the opposed mark as a house mark such that they are likely to believe that the composite mark under opposition to be an extension of the CRAFTED brand of the opponent or from economically linked undertakings...”

33. Having commented upon, inter alia, how the competing marks appear in use in the evidence provided, the opponent refers to the decision of the Appointed Person, Mr Iain Purvis Q.C, in *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), where he commented on the difference between direct and indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

The opponent states:

“17. All three instances identified may be applicable to this case. Consumers seeing a mark containing CRAFTED in connection with identical goods would assume it to be connected to the opponent, or simply a brand extension.”

34. The differences between the competing marks are, in my view, more than sufficient to avoid the likelihood of direct confusion i.e. where one mark is mistaken for the other. Insofar as indirect confusion is concerned, as I have already explained, in my view, the word CRAFTED is not a dominant element of the applicant’s mark nor, in my view, does it play an independent role within its mark. Bearing in mind what I consider to be the very low degree of inherent distinctive character the word CRAFTED possesses in relation to the goods at issue, I do not agree that the average consumer would, as the opponent suggests, see the word CRAFTED in the applicant’s mark as a house mark or the words which accompany it as a tag line. Put simply, I see no reason why the average consumer would rely upon this element of the applicant’s mark alone to denote trade origin. Rather, the average consumer is, in my view, much more likely to assume that the word CRAFTED in the applicant’s mark has, given its obvious highly allusive meaning, been adopted by the applicant to form part of a unitary mark the totality of which is also highly allusive. It follows that, in my view, there is no likelihood of indirect confusion either.

## **Conclusion**

**35. As a consequence of the above conclusions, the opposition fails and, subject to any successful appeal, the application will proceed to registration.**

## **Costs**

36. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent’s statement:	£200
Preparing evidence and considering the opponent’s evidence:	£500
<b>Total:</b>	<b>£700</b>

37. I order Republic (IP) Limited to pay to Denim Merchants (UK) Limited the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 13th day of August 2014**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**